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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,464	03/25/2004	Ryan Cunningham	UN00-P04042US	9324
33356 7590 11/25/2008 SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362				
EXAMINER COONEY, ADAM A				
ART UNIT		PAPER NUMBER		
2444				
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11/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,464

Applicant(s)

CUNNINGHAM ET AL.

Examiner

ADAM COONEY

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-63, 70 and 73-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-63, 70 and 73-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/11/2008 has been entered.
2. Applicant amended claims 61-63 and 70, cancelled claims 64-69 and 71-72, and added new claims 73-83. Thus, claims 61-63, 70 and 73-83 are pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
6. Claims 61-63, 70 and 73-83 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,353,267 B1. Although

the conflicting claim(s) are not identical, they are not patentably distinct from each other because of the following reason noted below.

Instant Application 10/810464	U.S. Patent No. 7,353,267 B1
<p>Claim 61: A process of providing a computer with access to web page content, the process comprising: <u>comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file; identifying a time period over which the ad file should be played; adding the ad file to a playlist for a computer if the ad file is matched to the demographic information of a registered user of the computer and if the identified time period is available for the computer; detecting a network connection initiated by the computer to allow the computer to download at least one web page for display in a browser window; detecting if the computer is not actively sending and not actively receiving data via the network connection, and if so, automatically downloading the ad file via the network connection to the computer, after completing downloading the ad file, the computer; storing the ad file in an ad pool; periodically opening a viewer window in which one or more ads from the ad pool are displayed; hiding the viewer window after a predetermined display run time and keeping the viewer program hidden for a predetermined quiet interval</u></p> <p><i>"A process of providing a computer with access to web page content" in claim 61 can be derived from "a method of providing a</i></p>	<p>Claim 1: A method of providing a user computer with access to files of a network, the method comprising: establishing a communication link from the user computer to an access control system of the network, wherein establishing a communication link includes: receiving user identification information, verifying demographic information for the identified user stored at the access control system and providing the communication link, collecting demographic information from the user computer in an initial registration and access operation, storing the demographic information at the access control system and identifying it with the registered user, and providing the communication link, and otherwise terminating the communication link and denying network access; launching a viewer program that controls a status of the communication link; detecting times when the user is not actively sending or receiving data from the network, and downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files at the user computer for display and performs ad pool management tasks; periodically opening a viewer program window in which a next ad file from the ad file pool is displayed; hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval; managing the ad file pool so as to keep track of the number of times each ad file in the ad file pool has been</p>

user computer with access to files of a network" as recited in claim 1 of the U.S. Patent because web page content can be a file from a network.

"comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file" in claim 61 is identical to "comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file" as recited in claim 1 of the U.S. Patent.

"identifying a time period over which the ad file should be played" in claim 61 is identical to "identifying a time period over which the ad file should be played" as recited by claim 1 of the U.S. Patent

"adding the ad file to a playlist for a computer if the ad file is matched to the demographic information of a registered user of the computer and if the identified time period is available for the computer" in claim 61 can be derived from "adding the ad file to a playlist for each registered computer user if the ad file is matched to the computer user demographic information and if the identified time period is available for the computer user" as recited by claim 1 of the U.S. Patent because "a computer" is a subset of "each computer user"

"detecting a network connection initiated by the computer to allow the computer to download at least one web page for display in a browser window" in claim 61 can be derived

viewed and determine when each ad file in the ad file pool should no longer be viewed; determining ad impression viewing data corresponding to the number of times each ad file in the ad file pool has been viewed; determining click through data corresponding to network addresses visited by the user during the viewing of an ad file; reporting the ad impression viewing data to the access control system; preparing a Demographic Report that summarizes the reported ad impression viewing data for multiple computer users over a current time period; comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file; identifying a time period over which the ad file should be played; adding the ad file to a playlist for each registered computer user if the ad file is matched to the computer user demographic information and if the identified time period is available for the computer user; and decreasing an available ad file impression number for each identified and matched computer user.

from "detecting times when a user is not actively sending or receiving data from the network, and downloading ad files from the network to the user computer during such times" as recited by claim 1 in the U.S. Patent because in order to detect if the user is active on the network a network connection had to be initiated, also one web page can be a form of ad files, which when downloaded to a the computer it will be displayed.

"detecting if the computer is not actively sending and not actively receiving data via the network connection, and if so, automatically downloading the ad file via the network connection to the computer" in claim 61 can be derived from "detecting times when a user is not actively sending or receiving data from the network, and downloading ad files from the network to the user computer during such times" as recited by claim 1 in the U.S. Patent because automatically downloading can be a subset of downloading and would be obvious to do so.

"after completing downloading the ad file, the computer storing the ad file in an ad pool" in claim 61 can be derived from "downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files" as recited in claim 1 of the U.S. Patent because in order to maintain a pool of ad files, the ad files had to be stored.

"periodically opening a viewer window in which one or more ads from the ad pool are displayed" in claim 61 can be derived from "periodically opening a viewer program window in which a next ad file from the ad file pool is displayed" as recited in claim 1 of the U.S. Patent because "one or more ads" is a subset of "a next ad file".

<p><i>"hiding the viewer window after a predetermined display run time and keeping the viewer program hidden for a predetermined quiet interval" in claim 61 can be derived from "hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval" as recited in claim 1 of the U.S. Patent because a "predetermined display run time" can include "a number of ad file" that were played, meaning the run time.</i></p>	
<p>Claim 80: A process of providing ads to a computer: comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file; identifying a time period over which the ad file should be played; adding the ad file to a playlist for a computer if the ad file is matched to the demographic information of a registered user of the computer and if the identified time period is available for the computer; detecting a network connection initiated by the computer to allow the computer to download at least one web page for display in a browser window; detecting if the computer is not actively sending and not actively receiving data via the network connection, and if so, automatically downloading the ad file via the network connection to the computer, after completing downloading the ad file, the computer;</p> <p><i>"A process of providing ads to a computer" in claim 80 can be derived from "a method of providing a user computer with access to files of a network" as recited in claim 1 of the U.S. Patent because the ads can be the files from</i></p>	<p>Claim 1: A method of providing a user computer with access to files of a network, the method comprising: establishing a communication link from the user computer to an access control system of the network, wherein establishing a communication link includes: receiving user identification information, verifying demographic information for the identified user stored at the access control system and providing the communication link, collecting demographic information from the user computer in an initial registration and access operation, storing the demographic information at the access control system and identifying it with the registered user, and providing the communication link, and otherwise terminating the communication link and denying network access; launching a viewer program that controls a status of the communication link; detecting times when the user is not actively sending or receiving data from the network, and downloading ad files from the network to the user computer during such times, such that the viewer program maintains a pool of ad files at the user computer for display and performs ad pool management tasks; periodically opening a viewer program window in which a next ad file from the ad file pool is displayed;</p>

the network.

“comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file” in claim 80 is identical to “comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file” as recited in claim 1 of the U.S. Patent.

“identifying a time period over which the ad file should be played” in claim 80 is identical to “identifying a time period over which the ad file should be played” as recited by claim 1 of the U.S. Patent.

“adding the ad file to a playlist for a computer if the ad file is matched to the demographic information of a registered user of the computer and if the identified time period is available for the computer” in claim 80 can be derived from “adding the ad file to a playlist for each registered computer user if the ad file is matched to the computer user demographic information and if the identified time period is available for the computer user” as recited by claim 1 of the U.S. Patent because “a computer” is a subset of “each computer user”.

“detecting a network connection initiated by the computer to allow the computer to download at least one web page for display in a browser window” in claim 80 can be derived from “detecting times when a user is not actively sending or receiving data from the network, and downloading ad files from the

hiding the viewer program window after a predetermined number of ad files from the ad file pool have been played and keeping the viewer program window hidden for a predetermined quiet interval; managing the ad file pool so as to keep track of the number of times each ad file in the ad file pool has been viewed and determine when each ad file in the ad file pool should no longer be viewed; determining ad impression viewing data corresponding to the number of times each ad file in the ad file pool has been viewed; determining click through data corresponding to network addresses visited by the user during the viewing of an ad file; reporting the ad impression viewing data to the access control system; preparing a Demographic Report that summarizes the reported ad impression viewing data for multiple computer users over a current time period; comparing an ad file having an associated demographic profile with demographic data for each of multiple registered users and identifying those registered users having demographic information that matches the demographic profile for the ad file; identifying a time period over which the ad file should be played; adding the ad file to a playlist for each registered computer user if the ad file is matched to the computer user demographic information and if the identified time period is available for the computer user; and decreasing an available ad file impression number for each identified and matched computer user.

network to the user computer during such times" as recited by claim 1 in the U.S. Patent because in order to detect if the user is active on the network a network connection had to be initiated, also one web page can be a form of ad files, which when downloaded to a the computer it will be displayed.

"detecting if the computer is not actively sending and not actively receiving data via the network connection, and if so, automatically downloading the ad file via the network connection to the computer" in claim 80 can be derived from "detecting times when a user is not actively sending or receiving data from the network, and downloading ad files from the network to the user computer during such times" as recited by claim 1 in the U.S. Patent because automatically downloading can be a subset of downloading and would be obvious to do so.

7. Furthermore, regarding claims 62, 63, 70, 73-79 and 81-83 are also rejected on the grounds of nonstatutory obviousness-type double patenting, based on their dependency of the rejected independent claims 61 and 80, respectively.

Response to Arguments

8. Applicant's arguments with respect to claims 61-63 and 70 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendments necessitated the new ground(s) of rejection presented in this Office Action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM COONEY whose telephone number is (571)270-5653. The examiner can normally be reached on Monday-Thursday and every other Friday from 730AM-5PM..

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./
Examiner, Art Unit 2444
11/21/2008

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2446

